ESTTA Tracking number: **ESTTA632089**

Filing date: **10/10/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204122
Party	Defendant Michael Liang
Correspondence Address	DAVID YAN LAW OFFICES OF DAVID YAN 136-20 38TH AVENUE, SUITE 11E FLUSHING, NY 11354 4232 UNITED STATES davidyanlawfirm@yahoo.com
Submission	Other Motions/Papers
Filer's Name	David Yan
Filer's e-mail	davidyanlawfirm@yahoo.com
Signature	/David Yan/
Date	10/10/2014
Attachments	Affirmation in Opposition to Opposer's Motion for Summary Judgment.pdf(22058 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 85/213,453
Filed: January 8, 2011
For Mark: NYC BEER LAGER and Design
Published in the Official Gazette: December 6, 2011

EMPIRE STATE BUILDING COMPANY L.L.C.,	:	Opposition No.: 91204122
Opposer,	:	
v.	:	
MICHAEL LIANG,	:	
Applicant.	:	

Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S AFFIRMATION IN OPPOSITION TO THE OPPOSER'S MOTION FOR SUMMARY JUDGMENT

GENUINE DISPUTE AS TO THE MATERIAL FACT

Upon the annexed Declaration of Michael Liang ("Liang Decl.") and the exhibits thereto, and the memorandum of law set forth herein, Applicant hereby requests for an order, pursuant to T.B.M.P. § 528 and Fed. R. Civ. P. 56, denying the Opposer's motion for summary judgment in this proceeding. There is genuine dispute as to material fact that Applicant has a bona fide intention to use the mark at issue in the United States commerce at the time when he filed his intent-to-use application for registration, and Opposer is not entitled to any judgment as a matter of law.

MEMORANDUM IN SUPPORT OF MOTION

STATEMENT OF DISPUTED FACTS

In support its motion for summary judgment, Opposer relied on the erroneous translation of the Applicant's business plan written in Chinese into English, which is misleading and fraudulent. Opposer was put in notice when Opposer received the Applicant's answer to the Opposer' Amended Notice of Opposition that the translation was in error. Opposer, however, still knowingly uses such erroneous translation to support its motion for summary judgment.

Opposer's version of translation alleges that, "If [the mark] is approved, will plan to produce beer and related beverages in the United States and sell them in the China market." (Opposer's Exhibit D). The correct translation of the pertinent part of the Applicant's business plan from Chinese into English is that, "If [the mark] is approved, [we] will plan to produce beer and relevant beverages[.] [We will] sell [them] in the markets of the United States and China." This document does show a bona fide intent to use a mark in the United States commerce. As such, Opposer is not entitled to summary judgment as a matter of law.

ARGUMENT

OPPOSER HAS NOT ANY STANDING TO OPPOSE APPLICANT'S MARK

A. Opposer Makes the Motion is not the Same Party Who Filed Notice of Opposition

Opposer in the instant motion is ESRT Empire State Building, L.L.C., which is not the same party who filed Notice of Opposition on March 1, 2012. Empire State Building Company, L.L.C. is the opposer in the Notice of Opposition on March 1, 2012.

ESRT Empire State Building, L.L.C. has not made any prior motion to substitute itself as the opposer to replace initial opposer in the Notice of Opposition on March 1, 2012. The instant motion for summary judgment is not the proper form for ESRT Empire State Building, L.L.C. to

make the compound motion to substitute itself as the incoming opposer. Hence, ESRT Empire State Building, L.L.C. lacks the standing to make the instant motion.

B. Opposer Has Failed to Pass the Threshold Inquiry of Standing

Section 13 of the Trademark Act provides that an opposition to the registration of an applicant may be filed "by any person who believes that he would be damaged by the registration of a mark upon the principal register." "Purpose in inquiring standing is to prevent litigation where there is no real controversy between the parties" and Opposer is "no more than an intermeddler". *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 U.S.P.Q. 185, 197 (C.C.P.A. 1982).

There is not any confusion on the part of any member of the public between Opposer and Applicant and/or their respective marks and/or goods or services. For instance, U.S. Registration No. 1247058 with the work mark "NY" and the designed drawing that shows a "fanciful design of the **Empire State Building"** does not confuse any part of the member of the public where the owner of the U.S. Registration No. 1247058 Mark uses the Mark in the industries or areas in Skylines; Gravestones; Leaning Tower of Pisa; Space needle; Tombstones; Totem poles; Envelopes; Rectangles as carriers or rectangles as single or multiple lien borders and where Opposer uses its Empire State Building Marks in their registered areas of providing observation decks in a skyscraper for purposes of sightseeing and managing and leasing the real estate.

Opposer's Marks are registered in International Classes 36 and 41, namely, Registration Nos. 2411972, 2413667, 2429297 and 2430828. On the contrary, Applicant's Mark is for International Class 32. Hence, Opposer cannot show that it has any real interest in the matter. Accordingly, the Opposer's belief of damage, *if any*, is not support by any real or rational basis;

but is purely speculative. *See American Speech-Language-Hearing Assoc. v. Nat'l Hearing Aid Society,* 224 U.S.P.Q. 798, 801 (T.T.A.B. 1984).

Therefore, Opposer lacks the standing to make the summary judgment motion.

APPLICANT HAS A BONA FIDE INTENT TO USE APPLICANT'S MARK IN THE UNITED STATES COMMERCE IN CONNECTION WITH APPLICANT'S GOODS AT THE TIME HE FILED HIS APPLICATION

Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) dictates that, at the time an applicant files an intent to use application, he must have a bona fide intent to use the mark in commerce in connection with the goods covered by the Application.

Congress, however, in drafting the Trademark Law Revision Act of 1988 ("TLRA"), purposely omitted a statutory definition of the term "bona fide" as used in the phrase "bona fide intention," in the interest of preserving "the flexibility which is vital to the proper operation of the trademark registration system." 15 U.S.C. Section 1126(d)(2); *see also* S. Rep. No. 100-515, 100th Cong. 2d Sess. at 43 (1988) (hereinafter "S. Rep." at 24). However, the legislative history of the TLRA provides that "in connection with this bill, 'bona fide' should be read to mean a fair, objective determination of the applicant's intent based on all the circumstances," and that ". . .applicant's *bona fide* intention must reflect the good-faith circumstances surrounding the intended use." *Id; see also Lane Ltd. v. Jackson Int'l Trading co. et al.,* 33 U.S.P.Q.2d 1351, 1355 (T.T.A.B. 1994).

Similarly, the House report, H. Rep. No. 100-1028, 100th Cong. 2d Sess. (1988) (hereinafter "H. Rep.") provides as follows:

> By permitting applicants to seek protection of their marks through an "intent to use" system, there should be no need for "token use" of a mark simply to provide a basis for an application. The use of the term "bona fide" is meant to eliminate such "token use," and to require, based on an objective view of the circumstances, a good faith intention to eventually use the mark in a real and legitimate

> commercial sense. Obviously, what is [*16] real and legitimate will vary depending on the practices of the industry involved, and should be determined based on the standards of that particular industry.

H. Rep. at 8-9.

Thus, the determination of whether an applicant has a bona fide intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances. While the determination of whether the applicant has the requisite bona fide intention is to be an objective determination, neither the statute nor the legislative history of the TLRA specifies the particular type or quantum of objective evidence that an applicant must produce to corroborate or defend its claimed bona fide intention to use the mark in commerce. In contrast, the legislative history of the TLRA provides several specific examples of objective circumstances which, if proven, "may cast doubt on the bona fide nature of the intent or even disprove it entirely." S. Rep. at 23; *see also Lane Ltd.*, 33 U.S.P.Q.2d at 1355.

In the instant matter, Applicant has applied, in his entire life, only for the registration of the Mark, NYC BEER LAGER, Application Serial No. 85/213,453 in the United States. Applicant has never applied for the registration of any other mark. The circumstances indicate that Applicant has genuine bona fide intent to actually use the Mark in the United States commerce. Applicant's evidence pertaining to the implementation of its business plan and licensing program constitutes credible, objective corroboration of its statement in the application that it had a bona fide intention to use the mark in commerce on beer and relevant beverages (International Class 32).

First, Applicant's claimed bona fide intention to use his Mark in commerce on beer and relevant beverages (International Class 32) is corroborated by Applicant's business plans. Applicant planed prior to and at his application for registration of this Mark, he and his partners

contemplated that, "If [the mark] is approved, [he and his partners] will plan to produce beer and relevant beverages[.] [he and his partners will] sell [them] in the markets of the United States and China." His plan considered the hiring of salespersons in the United States and China. His plan also considered production and joint venture with other manufacturers to make his products on beer and relevant beverages (International Class 32). This document does show a bona fide intent to use a mark in the United States commerce.

Similarly, Applicant's claim of bona fide intention is also corroborated, in the circumstances of this case, by his attempts to locate a U.S. licensee who could manufacture his products on beer and relevant beverages (International Class 32) under his Mark. Applicant's declaration regarding him and his partners' efforts in licensing his Mark with a U.S. beer brewing company located in Harlem, New York City reveals the Applicant's bona fide intention. The U.S. beer brewing company located in Harlem, New York City produces Harlem Sugar Hill.

In short, the documentary evidence of record in this case is sufficient to establish as a matter of law that Applicant possessed the requisite bona fide intention to use its mark in commerce on beer and relevant beverages (International Class 32). Opposer has not presented, and presumably cannot present at trial, evidence of any other circumstances which might tend to cast doubt on or disprove Applicant's claim of bona fide intention.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board: (1) deny the Opposer's motion to substitute ESRT Empire State Building, L.L.C. for Empire State Building Company L.L.C. as Opposer; (2) deny the Opposer's motion for summary judgment on the ground of bona fide intention to use Applicant's Mark in connection with Applicant's Goods at

the time that he filed his Application; and (3) granting Applicant such further and other relief as the Board deems just and proper.

Dated: Flushing, New York
October 9, 2014

Respectfully submitted,

/David Yan/

David Yan, Esq.
Attorney for Applicant / Defendant
136-20 38th Avenue, Suite 11E
Flushing, New York 11354
Telephone: (718) 888-7788

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on October 9, 2014, I caused a true and correct copy of the foregoing Applicant's Affirmation in Opposition to the Opposer's Motion and supporting Declaration of Michael Liang and with exhibits to be sent via U.S. Post First Class Mail, postage prepaid, to Opposer's Attorney of Record, William M. Borchard, Esquire, Cowan Liebowitz, & Latman, P.C., located at 1133 Avenue of the Americas, New York, NY 10278.

/David Yan/
David Yan